LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
AUG 24 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 325

AMPTO, INC., a corporation,
Petitioner,

vs.

AMERICAN PHOTOCOPY EQUIPMENT COMPANY, a corporation (Substituted as Plaintiff-Appellant for COPEASE MANUFACTURING CO., INC.),
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI TO THE SUPERIOR COURT OF NEW JERSEY, APPELLATE DIVISION

CLAPP & EISENBERG,
Attorneys for Respondent.

ALFRED C. CLAPP,
Counsel for Respondent,
744 Broad Street,
Newark, New Jersey.

Adams Press Corp., 11 Commerce Street, Newark, N. J.—Market 3-8611-12

TABLE OF CONTENTS

	PAGE
I—Counter-Statement of the Question Presented	1
II—Counter-Statement of the Case	2
III—Reasons for Disallowing the Writ	8
Conclusion	15

Cases Cited

American Photocopy Equipment Company v. Speed-O-Print Corp. (D. C. N. D. Ill., Docket No. 60-C-1053, November 2, 1962)	7
American Well Works v. Lane & Bowler Co., 241 U. S. 257, 60 L. ed. 987, 36 S. Ct. 585 (1916)	12, 13
Becher v. Contoure Labs., Inc., 279 U. S. 388, 73 L. ed. 752, 49 S. Ct. 356 (1929)	10
Beck v. Washington, 369 U. S. 541, 8 L. ed. 2d 98, 82 S. Ct. 955 (1962)	14
Briggs v. United Shoe Machinery Co., 239 U. S. 48, 60 L. ed. 138, 36 S. Ct. 6 (1915)	9
Copease Mfg. Co. v. American Photocopy Equipment Co., 298 F. 2d 772 (7th Cir. 1961), reversing in part, 189 F. Supp. 535 (N. D. Ill. 1960)	2
Felix v. Schwarnweber, 125 U. S. 54, 31 L. ed. 687, 8 S. Ct. 759 (1888)	9
Geneva Furniture Mfg. Co. v. S. Karpen & Bros., 238 U. S. 254, 59 L. ed. 1295, 35 S. Ct. 788 (1915)	9
Herndon v. Georgia, 295 U. S. 441, 79 L. ed. 1530, 55 S. Ct. 794 (1935)	14

PAGE

Independent Wireless Teleg. Co. v. Radio Corp., 269 U. S. 459, 70 L. ed. 357, 46 S. Ct. 166 (1926) 9

Lear Siegler Inc. v. Atkins, 330 F. 2d 595 (9th Cir. 1964) 10

Luckett v. Delpark, 270 U. S. 496, 70 L. ed. 703, 46 S. Ct. 397 (1926) 9

Lumoprint-Zindler K.G. v. Boeger, decided November 27, 1962 (published December 21, 1962), First Court of Civil Law, Supreme Court of West Germany 6

MacGregor v. Westinghouse Electric & Mfg. Co., 329 U. S. 402, 91 L. ed. 380, 61 S. Ct. 421 (1947) 11, 12

Odell v. Farnsworth Co., 250 U. S. 501, 63 L. ed. 1111, 39 S. Ct. 516 (1919) 9

Pratt v. Paris Gaslight & Coke Co., 168 U. S. 255, 42 L. ed. 458, 18 S. Ct. 62 (1897) 10

Vanderveer v. Erie Malleable Iron Company, 238 F. 2d 510 (3rd Cir. 1956), cert den., 353 U. S. 937, 1 L. ed. 2d 760, 77 S. Ct. 815 (1957) 10, 11

Wade v. Lawler, 165 U. S. 624, 41 L. ed. 851, 17 S. Ct. 425 (1897) 9

Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co., 266 U. S. 342, 69 L. ed. 316, 45 S. Ct. 117 (1924) 8

Wilson v. Sanford, 51 U. S. (10 How.) 99, 13 L. ed. 344 (1850) 9

Zalkind v. Scheinman, 139 F. 2d 895 (2nd Cir. 1943) .. 13

Statute Cited

28 U.S.C.A.:

Sec. 1338 12

PAGE

Rule Cited

N. J. Rules of Court:

R.R. 4:53-2 5

Other Authorities Cited

167 A. L. R. 1118, *Anno.* 9

40 Am. Jur., Patents:

Sec. 170 9

21 C. J. S., Courts:

Sec. 526 9

Hart and Wechsler, The Federal Courts and The Federal System (1953):

p. 754 10

p. 765 13

62 Har. L. Rev. (1949):

p. 803 13

2 Moore's Fed. Prac. (2nd Ed. 1964):

Sec. 2.07 [2] 9, 10

Note, Federal and State Court Jurisdiction in Patent Matters 10

3 Walker, Patents (Deller's Ed.):

Secs. 413-414 9

I

Counter-Statment of the Question Presented

Should the Supreme Court of the United States grant certiorari in a case involving a legal question as to the authority of State courts, which has long since been settled contrary to Petitioner's contention, and involving also factual contentions as to the scope of a particular patent.

II

Counter-Statement of the Case

1. Copease Manufacturing Co., Inc. ("Copease") instituted this action for an accounting in the Superior Court of New Jersey, Chancery Division, seeking to recover royalties under a patent-licensing agreement. By the agreement, it granted to Ampto, Inc. ("Ampto"), Petitioner herein, a license to make, use and sell photocopying machines embodying the inventions covered by U. S. Patent No. 2,657,618, sometimes designated the Eisbein Patent. The New Jersey Superior Court, Chancery Division, in an oral opinion, dismissed the complaint on the ground that defendant's accused machines did not embody the inventions covered by the licensed patent, Petitioner's Appendix A and B (Petition, p. 17-28); but the New Jersey Superior Court, Appellate Division, reversed. Petitioner's Appendix C (Petition p. 29-65). It found the licensing agreement binding and held that the accused machines did embody the invention. The New Jersey Supreme Court denied Ampto's petition for certification. Petitioner's Appendix D (Petition p. 66).

2. While the appeal was pending in the New Jersey Superior Court, Appellate Division, the United States Court of Appeals for the Seventh Circuit had held the Eisbein patent valid. *Copease Mfg. Co. v. American Photocopy Equipment Co.*, 298 F. 2d 772 (7th Cir. 1961) reversing in part 189 F. Supp. 535 (N.D. Ill. 1960), the Court of Appeals stating:

> "The new and useful result reached by Eisbein was the first practical office photocopying system. By means of his machine, which was compact, light-weight, uncomplicated, inexpensive, capable of operation and maintenance even by inexperienced office personnel, and yet which produced copies of excellent quality and

photographic accuracy in only a few seconds' time, he took the diffusion process out of the laboratory and made it available on a practical basis for use in offices. He did this where others failed." 298 F. 2d at 782.

The defendant in the Federal litigation ("Apeco") then purchased the Eisbein patent and the outstanding corporate stock of Copease, the plaintiff in that litigation, and it (Apeco) was thereafter substituted as the party-appellant in the New Jersey Superior Court, Appellate Division, and stands now as Respondent to the present petition.

3. The remainder of Petitioner's Statement of the Case is devoted to a summation of what Petitioner deems to be "errors of the Appellate Division, which give rise to the question" (Petition, p. 6, l. 13) now presented by it to the United States Supreme Court. In Paragraphs 8 to 10 of its Statement of the Case (Petition, pp. 6, 7), Petitioner claims that the "Appellate Division determined the scope of the patent monopoly solely in terms of the language of the claims, notwithstanding the specification." The Appellate Division did use the phrase "notwithstanding the specifications", but it is quite apparent that Petitioner, for the purpose of making this point, has lifted the phrase out of context. The Appellate Division held:

> "But it is elementary that while the claims of a patent must be 'interpreted in the light of its specifications,' *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 217 (1940), it is the claims which are the real measure of the invention covered by the patent. *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961); 35 U.S.C.A. 112. * * * There is a substantial difference between interpreting a claim 'in the light of' the specifications, on the one hand, and raising the specifications to the level of a declaration of invention on the other." (Petitioner's Appendix C, p. 37, ll. 20-34).

Later in the opinion the Appellate Division again reverted to this point:

> "However, as noted above, while the specifications may shed light on the claims, it is axiomatic that the latter are the real measure of the invention covered by the patent [citing authorities]. In the specifications, the patentee is only required to 'set forth the *best* mode * * * of carrying out his invention'. (*Ibid.* (emphasis added). It is obvious that 'best' does not mean 'only,' see *Smith* v. *Snow*, 294 U.S. 1, 11 (1935), for 'if this were so [,] most patents would be of little worth. * * * The invention, of course, must be described and the mode of putting it to practical use, but the claims measure the invention'. *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, *supra* (210 U.S. at pp. 418-419). * * *
>
> "We thus conclude that *notwithstanding the specifications* of the patent the most reasonable and natural interpretation of the claim language last above quoted is that 'level of the liquid' refers to the point where the sheets enter the liquid. * * * To conclude otherwise because of the specifications would be 'to read the specifications, which taken in their entirety are merely descriptive or illustrative of [the] invention [citations omitted], as though they were claims whose function is to exclude from the patent all that is not specifically claimed'. *Marconi Wireless Teleg. Co.* v. *United States*, 320 U.S. 1, 23 (1943)" (Petitioner's Appendix C, p. 48, 49) (emphasis added).

The opinion of the Appellate Division on this issue is clearly sustained by the authorities. It plainly recognizes that the specifications may shed light on the claims, which in the last analysis "measure the invention"; but it does not hold, as Petitioner now claims, that the scope of the patent

is determined "solely" by the claims "notwithstanding the specifications."

4. Next, Petitioner asserts in its Statement of the Case—Par. 8 and 11 to 13 thereof (Petition, pp. 6 to 9)—that the Appellate Division "disregarded the *only* testimony in the case bearing on the scope of the invention" (emphasis added), viz., the testimony of defendant's expert. This is plain error (quite apart from the fact that it raises a wholly factual issue). Plaintiff produced at the trial an expert witness who testified at length with respect to the scope of the invention; in fact his testimony on the subject is more extensive than that of defendant's expert. With respect to the length of the upper and intermediate guide plates in the patented machine, a matter which seems to concern the Petitioner especially, the testimony of plaintiff's expert extends from P95a-1 to 95a-41; 133a-13 to 137a-30; and 172a-12 to 185a-33 (references are to plaintiff's appendix before the Appellate Division). The record before the Appellate Division therefore contains, not only the testimony of defendant's expert, but also the differing testimony of plaintiff's expert, both dealing with the scope of the patent. The court rejected that of defendant's expert.

5. Referring further to this testimony of defendant's expert, Petitioner asserts that the Appellate Division "made no finding of fact * * * contrary" (Petition, p. 8, l. 5) to his testimony. This too, is obvious error. Under the practice of New Jersey, where an opinion is filed dealing with the facts, it is "unnecessary [for a court] to make other findings of fact" (N.J. Rules of Court R.R. 4:53-2). The Appellate Division's findings of fact with respect to the scope of the invention and, in particular, the length of the upper and intermediate guide plates cover 20 pages of Ampto's Petition, namely, from the top of page 45 to the bottom of page 65. These are carefully detailed findings,

first stating in substance the contention of defendant's expert with respect to the upper and intermediate guide plates on the patented machine, and then spelling out clearly and (we submit) with much force its reason for rejecting that contention.

6. Next, Petitioner in Par. 14 to 16 of its Statement of the Case (Petition, pp. 9-10), argues that the Appellate Division "disregarded" *Lumoprint-Zindler K.G.* v. *Boeger*, a case decided November 27, 1962 (published December 21, 1962) by the First Court of Civil Law of the Supreme Court of West Germany. On the contrary the Appellate Division did not disregard this German case, but gave Ampto the benefit of the decision, although holding that the case should receive only "qualified weight because of the substantial difference in wording between the German patent and that involved here * * *" (Petitioner's Appendix C, p. 49, ll. 17 to 31).

7. Then in Paragraph 17 of its Statement of the Case (Petition, pp. 10-11), Petitioner claims that the Appellate Division "disregarded" the patentee's (Eisbein's) subsequent interpretation of his own patent. This obviously is not so. The Appellate Division carefully considered this alleged interpretation by Eisbein of his patent, and held that there was nothing to defendant's contention. See Appellate Division opinion, Petitioner's Appendix C, p. 51, l. 19 to p. 52, l. 7.

8. In Paragraph 18 of its Statement of the Case (Petition, p. 11), Ampto alleges that the Appellate Division "disregarded" the fact that Apeco in the litigation with Copease in the United States District Court for the Northern District of Illinois and in the appeal therefrom to the Court of Appeals of the Seventh Circuit, took a position contrary to that maintained by it in the New Jersey Appellate Division. In this Federal case, Copease sued Apeco

for infringement; Apeco defended on the ground that the Eisbein patent was invalid. The Seventh Circuit Court of Appeals rejected the defense and sustained the patent. Apeco then bought the Eisbein patent on the strength of the decision of the Court of Appeals, and having bought it on that basis, was entitled to have the benefit of this decision. While the New Jersey Appellate Division does not deal with this matter in its opinion, it nevertheless on the oral argument very strongly rejected Ampto's present contention.

9. After the decision of the Court of Appeals of the Seventh Circuit above referred to, a consent decree was entered by the District Court of the Northern District of Illinois in an action by Apeco against Speed-O-Print Corp. *American Photocopy Equipment Company* v. *Speed-O-Print Corp.* (D. C. N. D. Ill., Docket No. 60-C-1053, November 2, 1962). This was noted by the Appellate Division, although it did not rely on this decree for its conclusions (Petitioner's Appendix C, p. 37, ll. 2 to 9). By the terms of the consent decree it was adjudicated that "all photocopy machines manufactured for sale by defendant [Speed-O-Print Corp.]" constituted a violation of the Eisbein patent, resulting in a recovery from Speed-O-Print Corp. of $377,628.86 by way of damages for such infringement (Petition, p. 16, l. 16). Furthermore as shown by P5sa-32 (reference is made to p. 5 of Apeco's Supplemental Appendix before the Appellate Division, line 32), it was determined by this decree that one of the two machines with which the present action is concerned, namely the machine designated as Ampto 9, sold by Speed-O-Print Corp. to Petitioner, violated the Eisbein patent; and Apeco was held entitled to damages because of Speed-O-Print Corp.'s manufacture and sale of this very machine.

10. It might be added, in connection with Petitioner's discussion of the opinion of the Appellate Division, that

Petitioner in stating its reasons for the allowance of the writ cites *Westinghouse Elec. & Mfg. Co.* v. *Formica Insulation Co.*, 266 U. S. 342, 351, 69 L. ed. 316, 45 S. Ct. 117 (1924) for the proposition that while Petitioner, as licensee, is estopped to challenge the validity of its licensor's patent, still it may properly require the court to pass upon the scope of the patent. In particular, notwithstanding this estoppel (as held in a passage from *Formica Insulation Co.* cited by Petitioner) "the state of the art may be used to construe and narrow the claims of the patent." The force of the point escapes us, for the Appellate Division held precisely this. Petitioner's Appendix C, p. 43, ll. 5 to 16. Of course the rule which estops a licensee of a patent from attacking the validity of the patent applies in federal and state courts alike. The licensee should not be permitted to escape the obligations of his contract to pay money, by attacking the validity of the patent.

III

Reasons for Disallowing the Writ

1. "The Question Presented for Review" as stated in the Petition, is as follows:

> "In a State Court action for patent license royalties, does the Court have authority under the Patent Clause of the United States Constitution to determine the patent monopoly to be broader than the patented invention"?

Variations of this question are repeated on page 13 of the Petition, Pars. 2 to 4- all of them assuming that because of errors of the Appellate Division, the plaintiff acquired a patent monopoly broader than Eisbein's invention (one variation is so preposterous as to indicate that Petitioner has "conclusively" shown by the Petition that the Appel-

late Division is wrong. Petition, p. 13, ll. 18 and 20). There is no merit whatever to this assumption. But, leaving that aside, the question presented for review *seems to be,* in essence, whether a state court in action for royalties under a licensing agreement should have authority to pass upon the scope of the invention.

2. It is settled law in this country that a suit for royalties under a patent-licensing agreement is cognizable in a State court and that in such a suit the State court may determine the scope of a patent. That a suit by a patentee for royalties is cognizable in a State court, see *Luckett* v. *Delpark*, 270 U. S. 496, 70 L. ed. 703, 46 S. Ct. 397 (1926), where it was held:

> "It is a general rule that a suit by a patentee for royalties under a license or assignment granted by him * * * is not a suit under the patent laws of the United States, and cannot be maintained in a Federal Court as such."

There is a long line of cases decided by this court to this effect, including *Wilson* v. *Sanford*, 51 U. S. (10 How.) 99, 13 L. ed. 344 (1850); *Felix* v. *Schwarzwaeber*, 125 U. S. 54, 31 L. ed. 687, 8 S. Ct. 759 (1888); *Wade* v. *Lawler*, 165 U. S. 624, 41 L. ed. 851, 17 S. Ct. 425 (1897); *Geneva Furniture Mfg. Co.* v. *S. Karpen & Bros.*, 238 U. S. 254, 59 L. ed. 1295, 35 S. Ct. 788 (1915); *Briggs* v. *United Shoe Machinery Co.*, 239 U. S. 48, 60 L. ed. 138, 36 S. Ct. 6 (1915); *Odell* v. *Farnsworth Co.*, 250 U. S. 501, 63 L. ed. 1111, 39 S. Ct. 516 (1919); *Independent Wireless Teleg. Co.* v. *Radio Corp.*, 269 U. S. 459, 70 L. ed. 357, 46 S. Ct. 166 (1926); 40 *Am. Jur. Patents* §170, and particularly the pocket supplement, containing numerous citations; Annot. 167 ALR 1118; 21 C.J.S. Courts §526; 3 *Walker Patents* (Deller's ed.) §413, 414; 2 *Moore's Fed. Prac.* §2.07

[2] (2d ed. 1964); Note on *Federal and State Court Jurisdiction in Patent Matters*, Hart and Wechsler, *The Federal Courts and The Federal System*, 754 (1953).

3. In *Pratt* v. *Paris Gaslight & Coke Co.*, 168 U. S. 255, 42 L. ed. 458, 18 S. Ct. 62 (1897), a suit was brought in a State court for the price of a patented machine. The defense was that the patent was void, and hence that defendant had no right to use the machine. The case holds—and it is the sole point in the case—that the State court has the power to pass on the validity of a patent in an action on a contract. The court noted that in such an action, whether for royalties or otherwise:

> "* * * the principle seems well established that any defense which goes to the validity of the patent is available in the state courts."

To the same effect, see *Becher* v. *Contoure Labs., Inc.*, 279 U. S. 388, 73 L. ed. 752, 49 S. Ct. 356 (1929), an opinion by Mr. Justice Holmes holding that in an action to impose a constructive trust upon letters patent the State court has jurisdiction of the case even though the court is called upon to determine the validity of the patent. So it was held in *Lear Siegler Inc.* v. *Atkins*, 330 F. 2d. 595, 600 (9th Cir. 1964):

> "It follows, and the [Supreme] Court has held, in *Pratt* and in *Becher*, that in an action in a state court based upon [a patent licensing] agreement, the state court can, where it becomes necessary for it to do so in order to decide the case before it, pass upon the meaning, the scope, the validity, or the infringement of the patent."

In *Vanderveer* v. *Erie Malleable Iron Company*, 238 F. 2d. 510, 513 (3rd Cir. 1956), it was held:

> "Although the bringing of actions arising under the patent laws is admittedly restricted to the Federal Courts it has long been established that actions brought to enforce contracts of which a patent is the subject must in the absence of diversity of citizenship be brought in the state courts. The Supreme Court has held that a state court is empowered to determine questions, as distinguished from cases, arising under the patent laws, to try questions of title to patents, to construe and enforce contracts relating to patents, and to determine the validity of patents. * * *"

The case last cited held that

> "* * * a finding by a state court in a suit for royalties under a license agreement that the licensee's product was not within the claims of the patent, must be given the effect of collateral estoppel in a subsequent infringement suit between the same parties in the federal court, to the extent of precluding the assertion by the patent owner that the same product infringes the claims of the same patent. The fact of noninfringement must be taken as conclusively established. Beyond this, however, the federal court is not barred by the judgment of the state court * * *".

This court denied certiorari. 353 U. S. 937, 1 L. ed. 2d. 760, 77 S. Ct. 815 (1957).

4. Petitioner states that "the very point at issue" (Petition Pars. 8 and 9, pp. 14 and 15) was posed in *MacGregor v. Westinghouse Electric & Mfg. Co.*, 329 U. S. 402, 407, 91 L. ed. 380, 385, 61 S. Ct. 421, 423 (1947), but not answered by the court. The question raised in that case, to which Petitioner refers, was whether a "license contract should be held unenforceable in the courts" where the licensor "*had attempted to use it to extend the patent scope*

beyond its lawful coverage" (emphasis added). No attempt was made by Copease, through the licensing agreement here, to extend the scope of the Eisbein patent. Under the licensing agreement, Ampto simply "agrees to pay a royalty of six per cent (6%) of the net retail selling price for each photocopy machine embodying any of said inventions' covered by U. S. Patent No. 2,657,618 in the name of Walter Eisbein (P350a-40, Appellate Division); the license does not extend any further than the patent. Hence *MacGregor* is not pertinent to Petitioner's contention. But *MacGregor* does pass on another question which is pertinent to our contention. The *United States Supreme Court* in this opinion by Mr. Justice Black, *remanded the case to a State court*, the Supreme Court of Pennsylvania, "for a new trial *to determine the validity of Westinghouse's patent*" (emphasis added). If an issue as to the validity of a patent is cognizable in a state court, a fortiori an issue as to the scope of a patent is cognizable there. *MacGregor* is therefore in accord with the whole stream of authority cited on pages 9 to 11 *supra*, holding that in a suit in a state court for the recovery of royalties due under a patent license contract, the court may determine the validity and scope of the patent.

5. The statute gives to the Federal courts exclusive jurisdiction "of any civil action *arising under* any Act of Congress relating to patents," 28 U.S.C.A. §1338 (emphasis added). It has been repeatedly held that the policies underlying this statute do not extend so far as to give the Federal courts exclusive jurisdiction to decide incidental questions as to the scope of a patent which arise in a common law cause of action. See the cases cited in Paragraph 3 above with respect to a contract for the payment of royalties under a patent license. Such a cause of action cannot be deemed to be one arising under any Act of Congress. *American Well Works* v. *Lane & Bowler Co.*, 241 U.S. 257,

60 L. ed. 987, 36 S. Ct. 585 (1916), was a suit for slander of title to a patented device, the alleged slander being a statement by defendant that plaintiff's (patented) device infringed defendant's patented device. Mr. Justice HOLMES held for the court:

> "*A suit arises under the law that creates the cause of action* (emphasis added). The fact that the justification [which the defendant might plead, e.g., that plaintiff was in truth infringing defendant's patent] may involve the validity and infringement of a patent is no more material to the question under what law the suit is brought than it would be in an action of contract."

Hart & Wechsler, supra, p. 765, commenting on Mr. Justice HOLMES' test as to the phrase "arising under," say:

> "Holmes' test may also be used to explain a wide variety of cases in which an affirmative claim under federal law is in some sense an ingredient of the legal position which the plaintiff asserts but in which, by construction, the federal law does not confer the particular right of action sought to be enforced. Cases of contracts involving patent rights are of this type."

The cause of action which Apeco has against Ampto by reason of the latter's breach of its contract to pay royalties is not *created* by an Act of Congress; the State law creates it. Incidentally to overrule this settled rule of law and require the federal courts to take jurisdiction of all State court litigation which involves a patent question would be counter to the established "policy underlying the strict construction of the congressional grant of jurisdiction" (62 Har. L. Rev. 803 (1949))—and counter also to the tendency of our law resting in part on purely pragmatic grounds, "not to enlarge but to reduce federal jurisdiction" (*Zalkind v. Scheinman*, 139 F. 2d 895, 903 (2nd Cir. 1943)).

6. The Petition poses no question of such a dimension as to warrant the grant of certiorari. On the contrary it raises only a long settled question which has been, we submit, well settled. In the first place therefore, there plainly is no federal question presented here. In the second place, assuming *arguendo* that such a question is now presented, it was raised too late in the proceedings below to be of avail now. Not until Petitioner filed its petition to the Supreme Court of New Jersey for certification was this alleged question brought into the case; and the attempt on the part of Petitioner to show that it had been raised in the trial court or the Appellate Division is utterly without merit. In this case, as Petitioner states (Petition, p. 2, l. 19), "certiorari is directed to the Appellate Division pursuant to *Western Union* v. *Priester* (1928) 276 U.S. 252 [72 L. ed. 555] 48 S. Ct. 234 * * *" Raising the purported federal question for the first time in the petition to the New Jersey Supreme Court for certification puts Petitioner in no better position than if it had raised the point for the first time on a petition to the Appellate Division for rehearing (in fact Petitioner's position would be more meritorious if it had raised the question on such a petition to the Appellate Division, since then it would have brought the federal question home to the court which actually decided the case). But to raise the federal question for the first time on a rehearing petition to the Appellate Division would have been timely only "if the ruling of the state court could not have been anticipated and a petition for rehearing presented the first opportunity for raising it." *Herndon* v. *Georgia*, 295 U.S. 441, 79 L. ed. 1530, 55 S. Ct. 794 (1935); see also *Beck* v. *Washington*, 369 U.S. 541, 8 L. ed. 2d 98, 82 S. Ct. 955 (1962). It cannot be maintained by Petitioner that the purported federal question was brought into the case by the Appellate Division as a surprise or on a basis that "could not have been

anticipated." Petitioner obviously could have anticipated a finding by the Appellate Division that its apparatus embodied the Eisbein invention; this was the decision which Apeco was asking the Appellate Division to make. Such a decision, no matter how it was framed, would necessarily have raised the purported federal question under Petitioner's reasoning. Yet even with this expectation, Petitioner makes no mention of that question in any of the copious papers filed by it with the Appellate Division, nor in any way directly discusses the question. For this reason alone the Petition should be denied.

CONCLUSION

The writ of certiorari should be denied.

CLAPP & EISENBERG,
Attorneys for American Photocopy Equipment Company, Respondent.

ALFRED C. CLAPP,
Counsel for Respondent.